

## REMARKS

### I. PRELIMINARY REMARKS

Claims 1, 4 and 24 have been amended.<sup>1</sup> Non-elected claims 27-42 have been canceled. Claims 43-52 have been added. Claims 1-26 and 43-52 remain in the application. Claims 3, 6-10, 12-16 have been withdrawn from consideration. Reexamination and reconsideration of the application, as amended, are respectfully requested.

### II. FORMALISTIC ISSUES

Claim 4 has been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully submits that the rejection under 35 U.S.C. § 112 has been obviated by the amendment above. More specifically, claim 4 now states that "the elongate body defines a longitudinal axis and a perimeter extending around the longitudinal axis" and that "the stiffening member comprises an elongate member extending only partially around the perimeter." One example of such a stiffening member is represented by reference numeral 44 in Figure 6c (which is reproduced on the following page). The rejection under 35 U.S.C. § 112 should, therefore, be withdrawn.

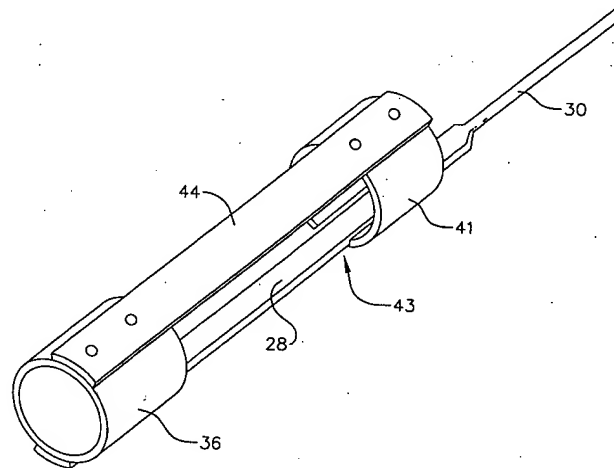
### III. BRIEF DESCRIPTION OF THE PREFERRED EMBODIMENTS

The present inventions, as defined by claims, are directed generally to steerable apparatus. As illustrated for example in Figure 1, an apparatus in accordance with one embodiment of a present invention includes a handle 12, an elongate body 14 and a steering wire 22. The proximal portion of the steering wire 22 is secured to the handle 12, while the distal portion is operably connected to the distal portion of the elongate

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<sup>1</sup> Applicant notes that claim 24 has merely been re-written in independent form.

body. Turning to Figure 6c, a formal version of which is reproduced below, the exemplary embodiment also includes a stiffening member 44. The distal portion of the exemplary steering wire 22 (identified by reference numeral 28 in Figure 6c) and the stiffening member 44 are both connected to an anchoring member 36. An anti-tear device 41 is associated with the stiffening member 44. As discussed in the specification at, for example, page 13, lines 3-12, the exemplary anti-tear device 41 "spreads the forces associated with the bending of the stiffening member 44 over a greater surface area, thereby preventing the bending member from tearing through the elongate body distal portion."



**Figure 6c**

#### **IV. PRIOR ART REJECTIONS**

##### **A. The Rejections**

Claims 1, 2, 4, 5, 11, 17-20 and 22-26 have been rejected under 35 U.S.C. § 102 as being anticipated by the Ebling patent (U.S. Patent No. 4,934,340). Claim 21 has been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Ebling patent and the Osborne patent (U.S. Patent No. 5,690,642). The rejections under 35 U.S.C. §§ 102 and 103 are respectfully traversed with respect to the claims as amended above. Reconsideration thereof is respectfully requested.

**B. The Ebling Patent**

The Ebling patent is directed to a bending assembly that may be used to steer a catheter through the body. As illustrated in Figures 1-3, the distal portion of a catheter 10 is provided with a contractile wire 20 and a support member 22, both of which are secured to a connecting member 24. The contractile wire 20, which shrinks when current passes therethrough, is disposed within the distal portion of the catheter 10. [Column 3, lines 20-35.]

**C. Discussion With Respect to Claims 1, 2, 4, 5, 11, 17-20, 22, 23 and 26**

Independent claim 1 calls for a combination of elements including, *inter alia*, "an elongate body," "a steering wire having a proximal portion that extends to the proximal portion of the elongate body and a distal portion that is operably connected to the distal portion of the elongate body," "a stiffening member associated with the distal portion of the elongate body" and "a handle, operably connected to the elongate body and to the steering wire, adapted pull the steering wire relative to the elongate body."

The Ebling patent fails to teach or suggest such a combination. For example, the Ebling catheter 10 is deflected by the contractile wire 20, which is located in the distal portion of the catheter. The Ebling patent does not teach or suggest the use of a steering wire that extends to the proximal portion of the elongate body, or the use of a handle that is adapted to pull the steering wire relative to the elongate body, as is called for in the combination defined by independent claim 1.

As the Ebling patent fails to teach or suggest each and every element of the combination recited in independent claim 1, applicant respectfully submits that claims 1, 2, 4, 5, 11, 17-20, 22, 23 and 26 are patentable thereover and that the rejection under 35 U.S.C. § 102 should be withdrawn.

#### D. Discussion With Respect to Claim 21

Applicant respectfully submits that the Osborne patent, which has been cited with respect to dependent claim 21, fails to remedy the aforementioned deficiencies in the Ebling patent. As such, claim 21 is patentable for at least the same reasons as independent claim 1 and the rejection of claim 21 under 35 U.S.C. § 103 should also be withdrawn.

#### E. Discussion With Respect to Claims 24 and 25

Independent claim 24 calls for a combination of elements including, *inter alia*, “an elongate body,” “a steering wire,” “***an anchoring member*** associated with the distal portion of the elongate body and ***secured to the steering wire***,” “***a stiffening member*** ... defining a distal end ***secured to the anchoring member***” and “***an anti-tear device associated with the stiffening member***.”

The Ebling patent fails to teach or suggest such a combination. For example, the Office Action has taken the position that the element represented by reference numeral 14a corresponds to the claimed “anti-tear device.” [Office Action at page 3.] Applicant respectfully submits that such an interpretation of the claim is simply incorrect. Referring to Figure 4 and column 5, lines 51-53 of the Ebling patent, reference numeral 14a represents nothing more than the proximal end of the elongate body 10a. Even assuming for the sake of argument that the Ebling contractile wire 20 corresponds to the “steering wire,” that the Ebling connecting member 24 corresponds to the “anchoring member,” and that the Ebling support member 22 corresponds to the claimed “stiffening member,” the Ebling elongate body proximal end 14a simply is not an “anti-tear device” that is associated with the support member 22.<sup>2</sup>

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<sup>2</sup> As discussed in *In re Cortright*, 49 USPQ2d 1464, 1467 (Fed. Cir. 1999), claims in an application are to be given their broadest reasonable interpretation. This interpretation must be “consistent with the specification” and “consistent with the one that those skilled in the art would reach.” *Id.*

As the Ebling patent fails to teach or suggest each and every element of the combination recited in independent claim 24, applicant respectfully submits that claims 24 and 25 are patentable thereover and that the rejection under 35 U.S.C. § 102 should be withdrawn.

#### **V. NEWLY PRESENTED CLAIMS 43-52**

Newly presented claims 43-46 depend from independent claim 24 and, accordingly, are patentable for at least the same reasons as independent claim 24.

Newly presented independent claim 47 calls for a combination of elements including "an elongate body defining a proximal portion and a distal portion and including a wall defining an inner surface, an outer surface and a lumen extending from the proximal portion to an aperture in the distal portion," "a steering wire having a distal portion operably connected to the distal portion of the elongate body," "a stiffening member associated with the distal portion of the elongate body" and "an anti-tear device associated with the stiffening member." Applicant respectfully submits that the cited references fail to teach or suggest such a combination and that claims 47-52 are patentable thereover.

#### **VI. CLOSING REMARKS**

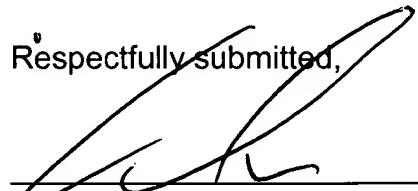
In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are respectfully requested. Allowance of the claims at an early date is courteously solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's undersigned representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-0638. Should such fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

6/6/03  
Date

**Henricks, Slavin & Holmes LLP**  
840 Apollo Street, Suite 200  
El Segundo, CA 90245  
(310) 563-1458  
(310) 563-1460 (Facsimile)

Respectfully submitted,  
  
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Craig A. Slavin  
Reg. No. 35,362  
Attorney for Applicant

**VERSION OF AMENDMENTS TO APPLICATION WITH  
MARKINGS TO SHOW CHANGES MADE**

***Claims 1, 4 and 24 have been amended as follows:***

1. (Amended) An apparatus, comprising:
  - an elongate body defining a proximal portion and a distal portion and including a wall defining an inner surface, an outer surface and a lumen extending from the proximal portion to an aperture in the distal portion;
  - a steering wire having a proximal portion that extends to the proximal portion of the elongate body and a distal portion that is operably connected to the distal portion of the elongate body; [and]
  - a stiffening member associated with the distal portion of the elongate body; and
  - a handle, operably connected to the elongate body and to the steering wire, adapted pull the steering wire relative to the elongate body.
4. (Amended) An apparatus as claimed in claim 1, wherein the elongate body defines a longitudinal axis and a perimeter extending around the longitudinal axis and the stiffening member comprises an elongate member extending only partially around the perimeter.
24. (Amended) An apparatus [as claimed in claim 23] , [further] comprising:
  - an elongate body defining a proximal portion and a distal portion and including a wall defining an inner surface, an outer surface and a lumen extending from the proximal portion to an aperture in the distal portion;
  - a steering wire having a distal portion;
  - an anchoring member associated with the distal portion of the elongate body and secured to the steering wire;
  - a stiffening member associated with the distal portion of the elongate body and defining a distal end secured to the anchoring member; and
  - an anti-tear device associated with the stiffening member.